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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/777,217

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Carlton J. Sparrell

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COVINGTON & BURLING, LLP

ATTN: PATENT DOCKETING

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EXAMINER

FEATHERSTONE, MARK D

ART UNIT

PAPER NUMBER

4157

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/777,217

Applicant(s)

SPARRELL ET AL.

Examiner

MARK D. FEATHERSTONE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/13/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4, 11, 15, 22, 26, 33, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 4, 11, 15, 22, 26, and 33:

These claims refer to a home area network that is located "approximately adjacent" to a customer premises. It is unclear to the examiner what the specific definition of "approximately adjacent" means.

With regard to claim 35, See MPEP 2173.05(p) Claim Directed to Product-By-Process or Product and Process

"A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process." In the instant case, the product is presumably "a medium" having encoded instructions as defined by the method steps i.e., the process. However, when considering the claim wholly, it not clear whether the claim pertains to the product or the process. Therefore, claim 35 is an improper product-by-process claim.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 35 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 35 is directed to "a signal" embedded in "a medium". However, the medium could be construed as a carrier wave (see applicant's specification, paragraph 00043), and the signal as data, albeit, functional descriptive material (see MPEP 2106.01 (I) for definition) as later defined as "encoded instructions" executed by a computer. Nevertheless, the probability of the medium being a carrier wave renders the claim wholly nonstatutory. See 35 USC 101 Interim Guideline, Annex IV (c). "...it does not appear a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101[.]"

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent; or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English.

6. Claims 1-3, 5-6, 12-14, 16-17, 23-25, 27-28, 34, and 35 are rejected under 35

U.S.C. 102(e) as being anticipated by Rosser, US Patent 6446261.

With regard to claim 1, Rosser discloses:

A home network (Fig. 1 – it is noted by the examiner that the applicant defines a

"home area network" as consumer electronic devices connected together by

electronic cable in paragraph 0006 of the disclosure) comprising a plurality of

rendering devices (Figure 1, item 56) and an advertisement manager, a method for

selecting a targeted advertisement for insertion in a content stream, the method

comprising:

identifying an active rendering device from among the plurality of rendering devices

(Column 3, lines 49-53; Rosser teaches a "viewer usage monitor" which records a

profile of "viewing habits". In order to view a program, the rendering device must be

active)

selecting, responsive to a profile associated with the active rendering device, a

targeted advertisement for insertion in a content stream rendered on the active

rendering device;

inserting the selected targeted advertisement in the content stream

(column 13, lines 25-36; Rosser here explains in detail the selection and insertion of

a targeted advertisement based on the user profile)

Wherein the selecting step is carried out by the advertisement manager (Rosser does not specifically call his application an "advertisement manager", but his in column 13, lines 25-36, it is inherent that the steps are carried out by an application running in the set top box)

With regard to claim 2, Rosser discloses:

The method of claim 1 wherein the profile associated with the active rendering device is updated by a profile application in the home area network (column 3, lines 49-57)

With regard to claim 3, Rosser discloses:

The method of claim 1, wherein the home area network is located wholly on the customer premises side of a demarcation point marking a separation from a carrier network (Figure 1, item 42 and Column 7, lines 21-24; In Figure 1, Rosser shows the separation between item 42 (the customer receiver device) and item 40 (the distribution means). Rosser describes the various end user types of connections that could be used, including a satellite connection or a conventional cable connection)

With regard to claim 5, Rosser discloses:

The method of claim 1, further comprising:
determining the time of rendering of the content stream on the active rendering device (column 9, line 49-53)
selecting the targeted advertisement additionally responsive to the determined time (column 13, lines 25-36)

With regard to claim 6, Rosser discloses:

The method of claim 1 further comprising:

identifying a user viewing the content stream on the active rendering device; and selecting the targeted advertisement additionally responsive to the identified user (column 15, lines 22-28; Rosser describes a number of different ways to identify a specific user of a device in order to target content to that individual)

Claims 12-14, and 16-17 are the apparatus to perform method claims 1-3, and 5-6, and are rejected on this basis.

Claims 23-25 and 27-28 are the computer readable medium with instructions to perform method claims 1-3 and 5-6, and are rejected on this basis.

Claim 34 is not distinct from claim 12. They both refer to the apparatus for selecting and inserting an advertisement into the content stream. It appears the difference in the claims is the language of an "advertisement manager" in claim 34. From applicant's disclosure, the advertisement manager is the application that drives the process for selecting/inserting advertisements, which is inherent in the apparatus that Rosser discloses in his patent.

Claim 35 is the signal embedded in a computer readable medium to cause the computer to perform the method of claim 1, and is rejected on this basis.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: (*See MPEP Ch. 2141*)

- a. Determining the scope and contents of the prior art;
- b. Ascertaining the differences between the prior art and the claims in issue;
- c. Resolving the level of ordinary skill in the pertinent art; and
- d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.

8. Claims 8-10, 19-21, and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Rosser" in view of "Markman et al, US PG Pub # 20030122966".

With regard to Claim 8, as stated above (claim 1 rejection), Rosser teaches:

A home area network comprising a plurality of rendering devices and an advertisement manager, a method for selecting a targeted advertisement for insertion in a content stream, the method comprising:

Identifying a first rendering device from among the plurality of rendering devices;

selecting, responsive to a first profile associated with the first active rendering device, a first targeted advertisement for insertion in a first content stream rendered on the first active rendering device;

inserting the first targeted advertisement in the first content stream;

However, Rosser fails to teach the following feature:

Identifying a second rendering device that is active from among the plurality of rendering devices;

a rendering, responsive to a second profile associated with the second active device, of a second targeted advertisement in a second content stream rendered on a second active rendering device, or
a rendering of the second content stream on the second active rendering device

Markman, in his patent application discloses the use of a single STB that provides functionality to multiple TVs (Fig. 3 and paragraph 0045).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine these two references in order to invent a single device that provides the ability to monitor and insert advertisements into a plurality of devices at the same time. The advantage of this would be to reduce hardware cost associated with multiple STBs.

Claim 9 recites the method of claim 8 with the feature that the second targeted advertisement is selected by the advertisement manager. (As stated in the claim 8 rejection, it would have been obvious to combine Rosser's and Markman's teachings in order to create a single device that provides functionality to multiple TVs, thus the application that drives this device would select the advertisements for multiple TVs.

Claim 10 recites the method of claim 8 with the added feature that the home area network is located wholly on the customer premises side of a demarcation point marking a separation from a carrier network (As stated in the claim 3 rejection, this feature is disclosed by Rosser in Figure 1, items 40 and column 7, lines 21-24. It would have been obvious at the time of the invention to one of ordinary skill in the art

to add this feature as Rosser specifically discloses it. The advantage of doing this would be to take advantage of the market interest in home networking.

Claims 19-21 are the apparatus to perform method claims 8-10, and are rejected on this basis.

Claims 30-32 are the computer-readable medium with the instructions to perform method claims 8-10, and are rejected on this basis.

9. Claims 7, 18, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Rosser" in view of "Ward III et al, US PG Pub #20020013941".

With regard to claim 7, Rosser teaches:

The method of claim 1 (see claim 1 rejection)

However, Rosser fails to teach the following feature:

Receiving a user-entered program-control command; and

Selecting the targeted advertisement additionally responsive to the received user-entered program-control command

Ward III, in his application, teaches the ability for a user to set controls to prevent viewing of content based on a variety of criteria, including rating, time, channel, and cost. (paragraph 0044)

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Rosser with the teachings of Ward to invent a system that targeted advertisements to viewers based partially on the program controls input by the viewer. The advantage of this would be to prevent inappropriate commercial content from being displayed to an unintended audience.

Claim 18 is the apparatus to perform method claim 7, and is rejected on this basis.

Claim 29 is the computer-readable storage medium to perform method claim 7, and is rejected on this basis.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK D. FEATHERSTONE whose telephone number is (571)270-3750. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F US Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

e-signed

/Mark Featherstone/ - Patent Examiner

/Vu Le/
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